

**Remarks****I. Administrative Overview**

Claims 1-40 were presented for examination. Applicant hereby amends Claims 1, 15 and 17, and cancels Claims 24-40. Applicant hereby adds Claims 41-45. Applicant requests entry of the present amendments before further consideration of the claims and the following remarks. Upon entry of the present amendments, Claims 1-23 and 41-45 will be presented for examination of which Claims 1, 17 and 41 are independent claims. Applicant respectfully requests allowance of all claims.

**II. Rejections Under 35 U.S.C. § 101**

Claims 1-40 are rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claims 24-40 have been cancelled thereby mooted the rejection with respect to those claims. Applicant respectfully submits that the amendments made to Claims 1 and 17 overcome this rejection.

Statutory subject matter includes “any new and useful process, machine, manufacture, or composition of matter under the sun that is made by man.” *See* *Diamond v. Chakrabarty*, 447 U.S. at 308-309 (1980). Claimed subject matter is “surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus.” *See* *In Re Bilski*, No. 2007-1130, Serial No. 08/833,892 at 10 (Fed. Cir. Oct. 30, 2008). Applicant respectfully submits that Claims 1 and 17 are tied to a particular machine or apparatus therefore they claim patentable subject matter.

Claims 1 and 17 recite a client that executes TWAIN proxy applications and a demultiplexor, and a client that is associated with an image-acquisition device. Claims 1 and 17 also recite a server that executes a redirector module and a TWAIN application. Thus Claims 1 and 17 are tied to a particular machine or apparatus comprising a client and a server having the above-mentioned attributes. Claims 2-16 and 18-23 depend on Claims 1 and 17, therefore they are tied to a particular machine or apparatus. Claims 1-23 therefore claim patentable subject matter. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

### **III. Rejections Under 35 U.S.C. § 112**

Claims 17-23 and 27-40 are rejected under 35 U.S.C. § 112 first paragraph for failing to comply with the written description requirement. Claims 27-40 have been cancelled thereby mooting the rejection with respect to those claims. Applicant respectfully submits that the amendments made to Claim 17 over this rejection. Therefore Applicant respectfully requests that the Examiner withdraw this rejection.

### **IV. Rejections under 35 U.S.C. § 103(a)**

#### **Claims 1, 5, 8-11, 16-18, 20 and 22-24**

Claims 1, 5, 8-11, 16-18, 20 and 22-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication Number 2004/0100651 A1 to Leone (“Leone”) in view of U.S. Patent Publication Number 2003/0014368 to Leurig (“Leurig”) in further view of U.S. Patent Number 7,142,333 to Struble (“Struble”) and in still further view of U.S. Patent Publication Number 2008/0189434 to Seki (“Seki”). Claim 24 has been cancelled thereby mooting the rejection with respect to this claim. Applicant respectfully submits that Claims 1, 5, 8-11, 16-18, 20 and 22-23 are patentable over any combination of Leone, Leurig, Struble and Seki. Nevertheless, Claims 1 and 17 have been amended to more clearly recite the claimed invention. Applicant respectfully submits that Claims 1, 5, 8-11, 16-18, 20 and 22-23, as amended, are patentable over Leone in view of Leurig in view of Struble and in further view of Seki.

A claimed invention is obvious only when one or more cited references, alone or combined, teach or suggest each and every element of the claimed invention. Applicant respectfully submits that Leone, Leurig, Struble and Seki fail to teach or suggest selecting a TWAIN proxy application from a plurality of TWAIN proxy applications where the selected TWAIN proxy application is associated with a TWAIN application program on a server as required by independent Claims 1, 17 and 41.

The Examiner admits that Leone, Leurig and Struble do not teach selecting a proxy application from a plurality of proxy applications executing on a client communication with a server, the selected proxy application associated with an application executing on a server. *See* Office Action mailed January 28, 2009, page 5. Therefore, none of these references teach or

suggest a TWAIN proxy application. Leone, Leurig and Struble therefore fail to teach or suggest each and every element of the claimed invention.

Seki describes proxy programs that are used to connect a LAN inside an ASP service center to a LAN inside a user's office, and compress. *See* Seki, page 4, paragraphs 69-70. There is no teaching or suggestion that either the server-side proxy or the client-side proxy correspond to a program executing on the other machine. Further, the proxies described in Seki are not TWAIN proxy applications. Therefore, Seki fails to teach or suggest each and every element of the claimed invention.

Claims 1, 17 and 41 are patentable over any combination of Leone, Leurig, Struble and Seki because no combination of these references will teach or suggest each and every element of the claimed invention. Claims 5, 8-11, 16, 18, 20 and 22-24 are also patentable over Leone, Leurig, Struble and Seki because Claims 5, 8-11, 16, 18, 20 and 22-24 depend on Claims 1 and 17. Applicant respectfully submits that the amendments made to Claims 1 and 17 overcome this rejection and therefore respectfully request that the Examiner withdraw this rejection.

#### Claims 2, 25

Claims 2 and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Leone in view of Leurig in view of Struble in view of Seki and in further view of U.S. Patent Number 6,654,784 to Wei ("Wei"). Claim 25 has been cancelled thereby mooted the rejection with respect to that claim. Applicant respectfully submits that Claim 2 as previously presented is patentable over any combination of Leone, Leurig, Struble, Seki and Wei.

Establishing *prima facie* obviousness of a claimed invention requires that the prior art teach or suggest each claim limitation. In view of the arguments stated above, Applicant respectfully submits that independent Claims 1, 17 and 41 are patentable and in a condition for allowance. Therefore Claim 2 is also patentable and in a condition for allowance because Claim 2 depends on and incorporates all the patentable subject matter of Claim 1. Furthermore, the Examiner cites Wei merely to address communicating via the ICA, RDP or X-WINDOWS protocol. Like Leone, Leurig, Struble and Seki, Wei also fails to teach or suggest selecting a TWAIN proxy application from a plurality of TWAIN proxy applications where the selected TWAIN proxy application is associated with a TWAIN application program on a server. Thus,

Wei fails to detract from the patentability of the claimed invention. Applicant therefore respectfully requests that the Examiner withdraw the rejection with respect to this claim.

Claims 3, 4, 19, 26-29, 32-35 and 40

Claims 3, 4, 19, 26-29, 32-35 and 40 are rejected under 35 U.S.C. § 103(a) as unpatentable over Leone in view of Leurig in view of Struble in view of Seki and in further view of Admitted Prior Art (“APA”). Claims 26-29, 32-35 and 40 have been cancelled thereby mooted the rejection with respect to those claims. Applicant respectfully submits that Claims 3, 4 and 19 as previously presented are patentable over any combination of Leone, Leurig, Struble, Seki and APA.

Establishing *prima facie* obviousness of a claimed invention requires that the prior art teach or suggest each claim limitation. In view of the arguments stated above, Applicant respectfully submits that independent Claims 1, 17 and 41 are patentable and in a condition for allowance. Therefore Claims 3, 4 and 19 are also patentable and in a condition for allowance because Claims 3, 4 and 19 depend on and incorporate all the patentable subject matter of Claims 1 and 17. Furthermore, the Examiner cites APA merely to address using a TWAIN API call. Like Leone, Leurig, Struble and Seki, APA also fails to teach or suggest selecting a TWAIN proxy application from a plurality of TWAIN proxy applications where the selected TWAIN proxy application is associated with a TWAIN application program on a server, because APA does not teach a TWAIN proxy application, APA teaches using a TWAIN protocol.<sup>1</sup> While Applicant may have admitted the TWAIN protocol, Applicant did not admit a TWAIN proxy application. Thus, APA fails to detract from the patentability of the claimed invention. Applicant therefore respectfully requests that the Examiner withdraw the rejection with respect to these claims.

Claims 6, 7 and 30-31

Claims 6, 7 and 30-31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Leone in view of Leurig in view of Struble in view of Seki and in further view of U.S. Patent Number 7,095,905 to Peterson (“Peterson”). Claims 30-31 have been cancelled thereby mooted the

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<sup>1</sup> The TWAIN protocol typically is used in conjunction with a image acquisition device that is locally connected to a computer, therefore the TWAIN protocol is not typically remoted.

rejection with respect to those claims. Applicant respectfully submits that Claims 6 and 7 as previously presented are patentable over any combination of Leone, Leurig, Struble, Seki and Peterson.

Establishing *prima facie* obviousness of a claimed invention requires that the prior art teach or suggest each claim limitation. In view of the arguments stated above, Applicant respectfully submits that independent Claims 1, 17 and 41 are patentable and in a condition for allowance. Therefore Claims 6 and 7 are also patentable and in a condition for allowance because Claims 6 and 7 depend on and incorporate all the patentable subject matter of Claim 1. Furthermore, the Examiner cites Peterson merely to address an issued command that includes an indication to suppress the display of a dialog box. Like Leone, Leurig, Struble and Seki, Peterson also fails to teach or suggest selecting a TWAIN proxy application from a plurality of TWAIN proxy applications where the selected TWAIN proxy application is associated with a TWAIN application program on a server. Thus, Peterson fails to detract from the patentability of the claimed invention. Applicant therefore respectfully requests that the Examiner withdraw the rejection with respect to these claims.

#### Claims 12-15 and 21

Claims 12-15 and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Leone in view of Leurig in view of Struble in view of Seki and in further view of U.S. Patent Number 5,267,051 to Dellert (“Dellert”). Applicant respectfully submits that Claims 12-15 and 21 as previously presented are patentable over any combination of Leone, Leurig, Struble, Seki and Dellert.

Establishing *prima facie* obviousness of a claimed invention requires that the prior art teach or suggest each claim limitation. In view of the arguments stated above, Applicant respectfully submits that independent Claims 1, 17 and 41 are patentable and in a condition for allowance. Therefore Claims 12-15 and 21 are also patentable and in a condition for allowance because Claims 12-15 and 21 depend on and incorporate all the patentable subject matter of Claims 1 and 17. Furthermore, the Examiner cites Dellert merely to address compressed image data. Like Leone, Leurig, Struble and Seki, Dellert also fails to teach or suggest selecting a TWAIN proxy application from a plurality of TWAIN proxy applications where the selected TWAIN proxy application is associated with a TWAIN application program on a server. Thus,

Dellert fails to detract from the patentability of the claimed invention. Applicant therefore respectfully requests that the Examiner withdraw the rejection with respect to these claims.

Claims 36-39

Claims 36-39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Leone in view of Leurig in view of Struble in view of Seki in view of APA and in further view of Dellert. Claims 36-39 have been cancelled thereby mooted the rejection with respect to those claims.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection with respect to these claims.

**V. Conclusion**

Applicant contends that each of the Examiner's rejections have been adequately addressed and that all of the pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all grounds of rejection, and allowance of the pending claims.

Should the Examiner feel that a telephone conference with Applicant's agent would expedite prosecution of this application; the Examiner is urged to contact the Applicant's agent at the telephone number identified below.

Respectfully submitted,  
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